

REMARKS

Claims 1-14 are pending. Claims 11-14 have been withdrawn from consideration. Claim 2 is currently canceled. Claims 1 and 5 are currently amended.

Claim 1 is amended to incorporate the limitations of claim 2. Claim 5 is amended for clarification. No new matter has been added.

Reconsideration of the application is requested.

§ 112 Rejections

Claim 5 was rejected under 35 USC § 112, second paragraph, as being indefinite. Claim 5 has been amended to remove the language “in particular”.

§ 102/103 Rejections

Claims 1-3 were rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Warner (WO 00/69594). Applicants respectfully traverse.

Warner does not anticipate or render the present claims obvious because Warner does not disclose either laser drilling a valve stem or sealing the liquid in the valve stem during drilling. While Warner may not preclude application to valve stems, there is no teaching recognizing the unique types of drug deposition problems that are associated with different ways of forming valve stem side-holes. It is thus only with hindsight based on the present disclosure that one would recognize the need and surprising benefits to laser drilling a liquid-filled valve stem according to the claimed invention.

Moreover, Warner does not disclose or suggest “sealing” the valve stem during laser drilling. The Office Action interprets the disclosure in Warner of using a stationary fluid as inherently requiring a step of sealing the fluid within the cavity. Alternatively, the Office Action argues that sealing the valve stem would be obvious in order to keep the fluid from leaking. Applicants respectfully disagree. There is no inherent requirement that a work piece must be sealed in order to have stationary fluid resting therein. Nothing in Warner hints at any such sealing step and Warner clearly teaches a preference for using moving fluid, not stationary. Therefore, even putting aside that fact that Warner does not disclose laser-drilling valve stems, Warner cannot

be deemed to anticipate or render obvious the present claims where the entire step of sealing is not disclosed or suggested in any way.

Claims 1-10 were also rejected under 35 USC 103(a) as being unpatentable over Alband (WO 99/55600) in view of Warner (WO 00/69594). Applicants respectfully traverse.

The combination of Alband and Warner still fails to teach the step of sealing the valve stem prior to laser-drilling. Alband relates to mechanical drilling and suggestions nothing about laser drilling. Warner, as noted above, does not disclose or suggest sealing the fluid in the valve stem prior to laser drilling. Accordingly, the asserted combination does not arrive at the claimed invention. Withdrawal of the rejection is therefore respectfully requested.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration and favorable action of the application are requested.

Respectfully submitted,

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